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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/460,007 | 12/13/1999 | DONALD K. HARPER, JR. | BERG-2462/C | 1903 |

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EXAMINER

NGUYEN, TRUC T

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 05/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/460,007

Applicant(s)

HARPER, JR., DONALD K.

Examiner

Truc T. T. Nguyen

Art Unit

2833

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Request for Continued Examination

The request filed on May 17, 2002 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/460,007 is acceptable and a RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 22-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art in view of Walker (US 5,788,510 and Examiner's Attachment from previous office action).

Applicant's APA substantially disclosed the claimed invention in Figure 1, except the a notch or a slot located at position generally furthest from a neutral point of the connector and extending through a distal end of the peripheral wall of the housing from an inner face to an outer face of the peripheral wall.

Walker discloses in Figure 1, an electrical connector housing (20) comprising a notch (E1) located only at location furthest from neutral point of the housing, the notch extending through a distal end of the peripheral wall from an inner face to an outer face.

Although Walker does not specifically disclose the slot (E1) is for the purpose of preventing warpage problem of the housing caused by thermal cycling. The structure, disclosed by Walker, would inherently obtain the advantage of the slot being presents in the housing. Thus, it has a capable of preventing warpage of the housing.

It would have been an obvious to one having ordinary skill in the art to modify the connection housing of the Applicant's APA with a slot only at furthest location from a neutral point of the housing. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation. *Ex Parte Masham, 2 USPQ2d 1647 (1987)*.

3. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art in view of Walker (US 5,788,510 and Examiner's Attachment from previous office action) and further in view of McHugh et al (US 6,033,236).

Claims 29-31 are rejected for the same reason as above.

In addition, Applicant's APA in view of Walker substantially disclosed the claimed invention, except a process of determining a location of the housing which may build up stress.

McHugh et al disclose a portion of the housing (12) is remove at location where the passageway (18) are located. The portion that was removed defined an opened slot (38) that will prevent the warpage problem of the housing (Figures 5B and column 3, lines 13-22).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to remove a portion of the housing where the stress is high as taught by McHugh.

Response to Arguments

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4. Applicant's arguments filed on 5/8/2002 have been fully considered but they are not persuasive. Because:

In response to applicant's argument on pages 4-5 of the Remark, the examiner respectfully disagrees.

A rejection base on rule of 35 U.S.C.103(a) can not be attacked by attacking each reference individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The examiner only use the teaching of Walker by having a notch on the peripheral walls of the connector. The Examiner recognizes that references cannot be arbitrarily combined and that there must some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is that the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In this case, Walker teaching the notch on the connector housing but silently disclose in the specification. The feature "notch" would suggest to one having ordinary skill in the art to combine with the applicant's prior art would provide the same function as claimed by the applicant.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Truc T. Nguyen whose telephone number is (703) 306-4004. The examiner can normally be reached on Monday through Thursday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Austin Bradley, can be reached on (703) 308-2319. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

T. Nguyen

May 17, 2002.

